

REMARKS

Applicant has carefully studied the Office Action of September 19, 2005, and offers the following remarks to accompany the above amendments.

The Patent Office objected to the specification for containing a number of informalities. Applicant herein amends the paragraph on page 1 to delete the attorney docket numbers. Applicant also deletes the partial paragraph on page 2 that duplicates the last part of the previous paragraph. Applicant also deletes the double negative of the paragraph on page 3, lines 11-12. Applicant also fixes a typographical error in the paragraph beginning on page 19, line 8. No new matter is added by any of these amendments, but the specification is put into better form. Applicant requests withdrawal of the objection to the specification at this time.

Claims 2, 4, and 9 were objected to for having various informalities. Specifically, claim 2 was objected to because the optional retail price and reseller commission allegedly did not further limit the claim. Applicant herein amends claims 2, 16, and 30 to delete the optional retail price and reseller commission. Claim 4 was objected to because "business" was improperly made plural. Applicant has herein amended claim 4 to make "business" singular. No new matter is added by these amendments. Applicant requests withdrawal of the objection to claims 2 and 4 at this time.

Applicant respectfully traverses the objection to claim 9. Specifically, the Patent Office alleges that the phrase "allowing the content owner to set the retail price and the reseller commission. . ." fails to limit the scope of the claim since the limitation is not positively recited. Applicant traverses this assertion.

Claim 1, from which claim 9 indirectly depends, recites in element a "maintaining a data repository for storing information relating to the files available in the digital marketplace, including business rules associated with each file that define electronic transfer of the files during commercial transactions. . . ." Thus, claim 9's language stating: "allowing the content owner to set the retail price and the reseller commission. . ." adds a limitation to claim 1, namely the function of allowing the content owner to do something. Since the allowing function is not recited in claim 1, 2, or 8 (from which claim 9 depends directly or indirectly), and the function of allowing the content owner to do something is positively recited, there is a new limitation in claim 9. Applicant requests withdrawal of the objection to claim 9 at this time. If the Patent Office disagrees with Applicant's analysis, Applicant requests that the Patent Office state with

greater particularity why allowing the content provider to perform a function is not positively recited and further limiting on the claims.

Applicant also amends claims 2-4, 8, 9, 15-17, 20, 22-24, 30, 31, 37, and 38 to clarify antecedent basis. No new matter is added.

Claims 1-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe in view of Gervais. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element can be found in the combination of references. MPEP § 2143.03. When determining whether the references or combination of references teaches an element, the Patent Office is entitled to interpret the claim elements broadly. However, this interpretation is limited in several respects. First, the interpretation is made in light of the specification. Further, the interpretation must be reasonable to someone skilled in the art. MPEP § 2111.

Applicant initially notes that the claimed invention is directed to the reselling of files, not generating income through referred sales of items, as taught by Wolfe. Comparing the claim language to the combination highlights this distinction.

Claim 1 specifically recites "maintaining a data repository for storing information relating to the files available in the digital marketplace." The Patent Office asserts that this element is shown in Wolfe paragraphs 0018 and 0064. Applicant respectfully traverses this assertion. Wolfe paragraph 0018 states in full: "http://www.merchant.com". This brief URL is simply a URL and makes no indication that files are available in a digital marketplace.

Paragraph 0064 states in full:

[0064] The database 28 contains a variety of information related to a merchant. In one embodiment, the merchant Web site 20 is operated by a merchant in the business of selling items. In such an embodiment, the database 28 includes information concerning items for sale and information concerning tracking and crediting commissions to affiliate accounts. Alternatively, the merchant Web site 20 may be operated for purposes other than sales. In such an embodiment, the database 28 may include information regarding the merchant's business in addition to information concerning tracking and crediting commissions to affiliate accounts.

The cited passage does indicate that a merchant sells items, but nowhere in Wolfe are these items for sale described as files. Applicant has studied Wolfe and finds no teaching therein that files are sold or resold as indicated in the claim. Thus, Wolfe does not teach or suggest the claimed

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element. Nothing in Gervais cures the deficiencies of Wolfe. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and the claim is allowable for this reason.

Claim 1 further recites "in response to a first user requesting to resell a particular file and thereby becoming a reseller. . . ." Thus, the claim requires that the files be resold. In contrast, Wolfe teaches an affiliate program wherein an affiliate earns commissions for referring customers to a merchant site. The customer purchases directly from the merchant web site and the affiliate gets the commission. At no time is the affiliate ever a reseller as that term is used in the specification. Applicant is cognizant that limitations of the specification are not imported into the claims, but the Patent Office is effectively reading the element "reseller" out of the claim by interpreting "reseller" to include the affiliates of Wolfe. Certainly no one skilled in the art would consider an affiliate who sells no product to be a reseller. To this extent, Wolfe does not teach or suggest the recited claim element. The Patent Office asserts that Wolfe teaches the claim element at column 15, lines 21-25. Wolfe is a published patent application, with the paragraphs numbered, and is not set forth in columns and line numbers. However, Applicant has reviewed column 15, lines 20-25, which appear on page 8 in paragraph 0080. Wolfe, column 15, lines 20-25 correspond roughly to the following passage:

The top frame 53 may continue to display content supplied from the affiliate Web site 10. The bottom frame 54 may contain information supplied by the merchant Web site 40, and the merchant Web site 40 may control what is displayed in this frame. However, the affiliate Web site 10 may still retain control of the overall frameset. Once action 600 has been executed, if the user performs an action on the merchant site 40 that generates a commission payment (as described in the explanation of FIG. 2), then that action may also generate a commission payment. Thus, the embodiments described herein allow for generating a commission payment not previously attainable in many situations.

This passage discusses the relationship between the affiliate and the website, indicating that the affiliate retains control over the customer's browser. The passage confirms that the user performs an action on the merchant site 40, effectively proving that the affiliate is not the entity from whom the customer makes the purchase (and thus precluding the affiliate from being the reseller of the claim). If Applicant has misconstrued the Patent Office's intended citation, Applicant requests that the Patent Office clarify the intended citation and afford Applicant a non-

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final Office Action to address the clarified citation. In the absence of such a clarification, the cited passage of Wolfe does not teach the claim element. Nothing in Gervais cures the deficiencies of Wolfe. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and the claim is allowable for this reason, as well.

Claim 1 further recites "using the data repository to dynamically generate a reseller uniform resource locator (RURL) that uniquely identifies the reseller and the file. . . ." Wolfe does not teach this element. Wolfe, in fact, criticizes URLs that identify the reseller and a particular product as impractical because of the delays associated in making such links live (see Wolfe paragraph 0040 "the majority of affiliate programs did not have the ability to link to an individual item. . . ." and paragraph 0045 "individual product links will not be 'active' for an hour or more. . . attempts to locate the link in its database . . . it will not be found."). Instead, Wolfe teaches using a bifurcated screen that has the affiliate control a frame within the browser. The first step to reaching the merchant is through the affiliate link so that the merchant can identify the affiliate, but then the frame is refreshed with an item URL that is not unique to the affiliate (see Wolfe paragraph 0077 that describes link 69 as not containing any affiliate identity codes). If anything, Wolfe teaches away from the concept of dynamic links that uniquely identify the reseller and the file. Since Wolfe not only does not teach this element, but in fact also teaches away from the element, the combination does not teach the claim element. Since the combination does not teach the claim element, the claim is non-obvious and allowable.

Claims 2-14 depend from claim 1 and are not obvious for at least the same reasons.

Claim 15 is substantially similar to claim 1, albeit in a computer software format. Thus, claim 15 is non-obvious for at least the same reasons.

Claims 16-28 depend from claim 15 and are not obvious for at least the same reasons.

Claim 29 recites, in relevant part, essentially the same elements as claim 1. That is, claim 29 recites "a data repository accessible by the server for storing information relating to the files available in the digital marketplace. . . "; "a first user contacting the server and requesting to resell a particular file and thereby becoming a reseller. . . "; and "uses the data repository to dynamically generate a reseller uniform resource locator (RURL) that uniquely identifies the reseller and the file. . . ." These correspond to the elements addressed above. As explained

above, Wolfe and Gervais do not teach or suggest these elements, and therefore claim 29 is not obvious. Claims 30-42 depend from claim 29 and are not obvious for at least the same reasons.

Applicant requests withdrawal of the § 103 rejection of claims 1-42 at this time.

Some dependent claims deserve special mention. Claims 5, 19, and 33 recite that the rules have a redistributable indicator that indicates whether the file is redistributable. The Patent Office asserts this is shown by Wolfe, paragraph 0027. Applicant respectfully traverses this assertion. Wolfe, paragraph 0027 states in full:

Note that the affiliate network's linking reference tag (the one after "href=" in the affiliate network's home page link) is a Web site operated by the affiliate network (e.g., affiliate-network.com), rather than the merchant. Thus, when the consumer is linked to the affiliate network's Web site, a tracking process may be triggered. Next, the affiliate network's Web server redirects the consumer to the merchant's Web site. The merchant's Web site continues the tracking process and reports any resulting sales and commissions back to the affiliate network. Once the consumer has been redirected from the affiliate network's Web site to the merchant's Web site, the URL displayed in the consumer's browser corresponds to the merchant's Web site, and not the affiliate network's Web site. In most cases, the consumer is unaware that he or she is first directed to the affiliate network's Web site before going to the merchant's Web site. For example, in the consumer's perspective, he or she visits a Web site, clicks on a link labeled "merchant.com" and is taken directly to the merchant.com site, complete with the merchant.com URL in the browser's address bar.

While the passage does describe the process of linking to the affiliate network, there is nothing in the passage that indicates the file is redistributable. Redirection is not the same as redistribution. If the Patent Office disagrees, Applicant requests that the Patent Office explain with greater particularity what, within this passage, is the redistributable indicator. In the absence of such an identification, the element is not shown. Nothing in Gervais cures the deficiencies of Wolfe. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the claims are non-obvious. Since the claims are non-obvious, the claims are independently patentable over the rejection of record.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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Date: December 14, 2005  
Attorney Docket: 1104-034

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